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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DUANE L. MCDONALD

Appeal 2009-012054
Application 10/749,988
Technology Center 3700

Before JOHN C. KERINS, STEFAN STAICOVICI, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

SILVERBERG, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Duane L. McDonald (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3-5, 7-14 and 16-26. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

THE INVENTION

Appellant's claimed invention is directed to packaging containing a single disposable absorbent article having an easy open feature (Spec. 1:8-10).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A package enclosing a single disposable garment-type absorbent article, the package comprising a first piece of material and a second piece of material, the first piece of material and the second piece of material being operatively associated with one another to enclose the absorbent article, the operative association defining a seal, wherein the first piece of material and the second piece of material have different rigidities, and wherein at least a portion of the first piece of material and at least a portion of the second piece of material extend beyond the seal to deliver an opening element.

THE REJECTIONS

The following rejections¹ by the Examiner are before us for review:

1. Claims 1, 3-5, 7-14 and 16-26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point

¹ The rejection of claims 8, 16 and 25 over Denny, Whitefoot and Narawa (Final Rej. 6), has been withdrawn by the Examiner (Ans. 2).

- out and distinctly claim the subject matter which applicant regards as the invention.
2. Claims 1, 3, 4, 7 and 10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Denny (US 3,403,776, issued Oct. 1, 1968).
 3. Claim 21 is rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Whitefoot (US 2,676,702, issued Apr. 27, 1954).
 4. Claims 1, 3-5, 7, 10-14, 20-24 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Denny in view of Whitefoot.
 5. Claims 9, 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Denny in view of Whitefoot, and further in view of Franks-Farah (US 6,640,976 B1, issued Nov. 4, 2003).
 6. Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Denny in view of Whitefoot and Franks-Farah, and further in view of Official Notice.
 7. Claims 1, 3, 4, 7, 10-14 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinberger (US 3,286,435, issued Nov. 22, 1966) in view of Denny or Anderson (US 4,896,768, issued Jan. 30, 1990).
 8. Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinberger in view of Denny or Anderson, and further in view of Whitefoot.
 9. Claims 8 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinberger in view of Denny or Anderson, and further in view of Narawa (JP 10-95481, published Apr. 14, 1998).

10. Claims 9, 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinberger in view of Denny or Anderson, and further in view of Franks-Farah.
11. Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinberger in view of Denny or Anderson and Franks-Farah, and further in view of Official Notice.
12. Claims 21 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinberger in view of Whitefoot.
13. Claims 22-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinberger in view of Whitefoot, and further in view of Denny or Anderson.
14. Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Weinberger in view of Whitefoot, and further in view of Narawa.

ISSUES

The issues before us are: (1) whether the Examiner erred in concluding that claims 1, 3-5, 7-14 and 16-26 are indefinite for failing to particularly point out and distinctly claim Appellant's invention (App. Br. 8); (2) whether the Examiner erred in finding that Denny describes a first piece of material and a second piece of material having different rigidities, as called for in independent claim 1 (App. Br. 8-9); (3) whether the Examiner erred in finding that Whitefoot describes a single garment-type absorbent article, as called for in independent claim 21 (App. Br. 10); (4) whether the Examiner erred in finding that Denny describes an absorbent article having a ratio of the folded configuration to the unfolded configuration of less than 0.14, as called for in independent claim 11 (App.

Br. 11); (5) whether the Examiner erred in concluding that the combined teachings of Denny and Whitefoot would have rendered obvious the package, as called for in independent claim 21 (App. Br. 11); (6) whether the Examiner erred in concluding that the combined teachings of Weinberger, and Denny or Anderson would have rendered obvious a first piece of material and a second piece of material having different rigidities, as called for in independent claim 1 (App. Br. 14); (7) whether the Examiner erred in finding that Weinberger describes a single disposable garment-type absorbent article, as called for in independent claim 11 (App. Br. 15); and (8) whether the Examiner erred in concluding that the combined teachings of Weinberger and Whitefoot would have rendered obvious the package, as called for in independent claim 21 (App. Br. 17).

ANALYSIS

Rejection of claims 1, 3-5, 7-14 and 16-26 under 35 U.S.C. § 112

The Examiner found the “[t]he phrase ‘garment-type’ in claims 1, 11 and 21 is vague, confusion [*sic.*, confusing] and indefinite because such phrase has no clear meaning” and “[i]t is not clear what type of a disposable absorbent article is included or excluded by such phrase” (Ans. 3).

Appellant contends that the meaning of the words garment-type “is clear, particularly in view of the specification of the present application” and the phrase “‘garment-type absorbent article’” is widely used in the art and has a clear meaning to one skilled in the art” (App. Br. 8).

The ordinary meaning of the word “garment” includes “an article of clothing.”²

² MERRIAM-WEBSTER’S COLLEGIATE DICTIONARY (10th ed. 1996)

We find that the term “garment-type” would be understood by persons of ordinary skill in the art to be directed to articles that are capable of being worn.

Thus, we find that the Examiner is confusing breadth with indefiniteness. Merely that a claim is broad does not mean that it is indefinite, that is, undue breadth is not indefiniteness. *See In re Johnson*, 558 F.2d 1008, 1016 n.17 (CCPA 1977) (“[U]ndue breadth is not indefiniteness.”)

We reverse the rejection of claims 1, 3-5, 7-14 and 16-26 under 35 U.S.C. § 112.

Rejection of claims 1, 3, 4, 7 and 10 under 35 U.S.C. § 102(b) over Denny

Independent claim 1 calls for, *inter alia*, “the first piece of material and the second piece of material have different rigidities.”

The Examiner found that Denny describes “the first piece of material formed from a paper and the second piece of material formed from a polypropylene film which is different rigidity than the first piece of material since the properties of paper and film are different” (Ans. 16).

Appellant contends that Denny does not describe “a first piece of material and a second piece of material, wherein the first piece of material and the second piece of material have different rigidities as required by claim 1” (App. Br. 8-9).

We agree with Appellant, as we find that Denny is silent as to the rigidities of the package materials **4, 5, 11, 12**. Thus, we find that the Examiner’s finding is based on speculation.

Rigidity is not a simple property of a material, as it depends on, *inter alia*, the particular material and the thickness of the material.

Therefore, just because two elements are made of different materials does not mean that the two elements necessarily are of different rigidities.

A rejection founded in anticipation cannot be predicated on conjecture as to how the allegedly anticipating structure is constructed and arranged. *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983) (“Anticipation of inventions set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references.”)

As such, we reverse the rejection of independent claim 1, and dependent claims 3, 4, 7 and 10.

Rejections of claim 21 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) over Whitefoot

Appellant contends that Whitefoot does not describe a single garment-type absorbent article (App. Br. 10).

The Examiner found that Whitefoot describes a “package containing bandages, sponges or gloves and each of bandages or sponges is inherently capable to be worn by a human between the human's skin and an article of clothing which is considered equivalent to a garment-type absorbent article as claimed” (Ans. 17).

The ordinary meaning of the word “bandage” includes “a strip of fabric used esp. to dress and bind up wounds” and “a flexible strip or band used to cover, strengthen, or compress something.”³

³ MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY (10th ed. 1996)

We find that bandages are intended to and do cover a wound that is a part of the body, and thus, are worn by a person.

As we found *supra*, the term “garment-type” is directed to an article that is capable of being worn..

Thus, we find that Whitefoot’s bandage describes a garment-type article, as called for in independent claim 21.

We affirm the 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) rejections of independent claim 21 over Whitefoot.

Rejection of claims 1, 3-5, 7, 10-14, 20-24 and 26 under 35 U.S.C. § 103(a) over Denny and Whitefoot

Claims 1, 3-5, 7 and 10

Appellant contends that Whitefoot does not correct the previously described deficiencies of Denny, that is, Whitefoot does not describe a first piece of material and a second piece of material, wherein the first piece of material and the second piece of material have different rigidities, as called for in claim 1 (App. Br. 11).

The Examiner’s conclusion of obviousness based on Denny and Whitefoot does not remedy the deficiency in Denny, as set forth *supra*, regarding Denny not describing a first and a second material having different rigidities, as called for in independent claim 1 (Ans. 6-7).

Thus, for the same reasons set forth *supra* regarding the rejection of claim 1 over Denny, we reverse the rejection of claim 1 and dependent claims 3-5, 7 and 10 over Denny and Whitefoot.

Claims 11-14 and 20

Independent claim 11 calls for, *inter alia*, “wherein the absorbent article has a ratio of the folded configuration to the unfolded configuration of less than 0.14.”

The Examiner found that “the absorbent article (2) of Denny is capable to provide a ratio in a folded configuration to an unfolded configuration of less than 0.14 because the absorbent article of Denny is capable to be folded to provide such ratio as claimed” (Ans. 7) (bold added).

Appellant contends that “it is purely conjecture on the part of the Examiner” that Denny’s absorbent article “is capable to be folded to provide a ratio in a folded configuration to an unfolded configuration of less than 0.14” (App. Br. 11).

Denny is silent as to whether the packaged article has a ratio between a folded configuration to an unfolded configuration of less than 0.14. At most, in Figure 1 Denny appears to disclose a ratio between a folded configuration to an unfolded configuration of 0.5. Thus we find that the Examiner’s finding is based on speculation. The Examiner has not relied on Whitefoot for any teaching that would remedy the deficiency in Denny (Ans. 6-7). *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (“The legal conclusion of obviousness must be supported by facts. Where the legal conclusion is not supported by facts it cannot stand.”)

As such, we reverse the rejection of independent claim 11, and dependent claims 12-14 and 20 over Denny and Whitefoot.

Claims 21-24 and 26

Claim 21

Appellant contends that (1) Denny does not correct the deficiencies of Whitefoot (App. Br. 11), and (2) neither Denny nor Whitefoot describes a garment-type absorbent article (*id.*).

The Examiner concluded that it would have been obvious to a person having ordinary skill in the art to modify the package of Denny to contain a bandage/garment-type article as taught by Whitefoot (Ans. 6).

We agree with the Examiner that Appellant's contention is in error, as the Examiner's conclusion of obviousness is based upon the teachings of Denny being modified by the teachings of Whitefoot, not the teachings of Whitefoot being modified by the teachings of Denny (Ans. 17).

As we found *supra*, Whitefoot describes a garment-type article, as called for in independent claim 21.

We affirm the rejection of independent claim 21 over Denny and Whitefoot.

Claims 22-24 and 26

Claim 22, from which claims 23, 24 and 26 depend, calls for "wherein the first piece of material and the second piece of material have different rigidities."

The Examiner's conclusion of obviousness based on Denny and Whitefoot does not remedy the deficiency in Denny, as set forth *supra*, regarding Denny not describing a first and a second material having different rigidities, as called for in independent claim 1 (Ans. 6-7).

Thus, for the same reasons set forth *supra* regarding the rejection of claim 1 over Denny and over Denny and Whitefoot, we reverse the rejection of claims 22-24 and 26 over Denny and Whitefoot.

Rejection of claims 9, 17 and 18 under 35 U.S.C. § 103(a) over Denny, Whitefoot and Franks-Farah

The Examiner has not relied on Franks-Farah for any teaching that would remedy the deficiency in the combined teachings of Denny and Whitefoot as to independent claims 1 and 11, from which the claims depend (Ans. 8).

Thus, for the same reasons set forth *supra* regarding the rejection of independent claims 1 and 11 over Denny and Whitefoot; we reverse the rejection of dependent claims 9, 17 and 18.

Rejection of claim 19 under 35 U.S.C. § 103(a) over Denny, Whitefoot, Franks-Farah and Official Notice

The Examiner has not relied on Official Notice for any teaching that would remedy the deficiency in the combined teachings of Denny and Whitefoot as to independent claim 11, from which claim 19 depends (Ans. 9).

Thus, for the same reasons set forth *supra* regarding the rejection of independent claim 11 over Denny and Whitefoot, we reverse the rejection of dependent claim 19.

*Rejection of claims 1, 3, 4, 7, 10-14 and 20 under 35 U.S.C. § 103(a) over
Weinberger, and Denny or Anderson*
Claims 1, 3, 4, 7 and 10

The Examiner's conclusion of obviousness relies on the teachings of Denny or Anderson for describing a first and a second material having different rigidities, as called for in independent claim 1.

As we found *supra* regarding Denny, Anderson is also silent as to the rigidities of the package materials 12, 16.

Thus, as we found *supra* regarding Denny, Anderson does not describe a first and a second material having different rigidities.

Thus, for the same reasons set forth *supra* regarding the rejection of independent claim 1 over Denny, we reverse the rejection of claims 1, 3, 4, 7 and 10 over Weinberger, and Denny or Anderson.

Claims 11-14 and 20

Independent Claim 11 calls for, *inter alia*, "a single disposable garment-type absorbent article."

Appellant contends that Weinberger does not describe a single disposable garment-type absorbent article, as called for in independent claim 11 (App. Br. 15).

The Examiner found that "Weinberger discloses the disposable absorbent article comprises a cleansing towel, napkin or the like" (Ans. 19).

Weinberger describes that (1) "[t]his invention relates to an improved moist packaged article" (col. 1, ll. 10-11), (2) "this invention relates to an improvement in disposable cleansing towels, napkins or the like," (col. 1, ll. 12-14), and (3) "it is an object of this invention to provide an improved disposable towel or napkin which can be readily unfolded even when *totally*

saturated with a liquid cleansing agent with a minimum of effort and a maximum of ease” (col. 1, ll. 49-53) (Emphasis added).

We find that a moist packaged article, especially one that is *totally saturated*, is not an absorbent article, as called for in independent claim 11.

Thus, we reverse the rejection of independent claim 11 and dependent claims 12-14 and 20.

Rejection of claim 5 under 35 U.S.C. § 103(a) over Weinberger, Denny or Anderson, and Whitefoot; claims 8 and 16 under 35 U.S.C. § 103(a) over Weinberger, Denny or Anderson, and Narawa; claims 9, 17 and 18 under 35 U.S.C. § 103(a) over Weinberger, Denny or Anderson, and Franks-Farah; and claim 19 under 35 U.S.C. § 103(a) over Weinberger, Denny or Anderson, Franks-Farah and Official Notice

The Examiner has not relied on Whitefoot, Narawa, Franks-Farah or Official Notice for any teaching that would remedy the deficiency in the combined teachings of Weinberger, Denny or Anderson, as to independent claims 1 and 11, from which the claims depend (Ans. 10-13).

Thus, for the same reasons set forth *supra* regarding the rejection of independent claims 1 and 11 over Weinberger, Denny or Anderson; we reverse the rejection of dependent claims 5, 8, 9 and 16-19.

Rejection of claim 21 under 35 U.S.C. § 103(a) over Weinberger in view of Whitefoot

Appellant contends that (1) Weinberger does not describe a garment-type absorbent article (App. Br. 17) and (2) the combined teachings of Weinberger and Whitefoot do not describe the claimed folded and unfolded configuration of the article (App. Br. 17-18).

Claim 21 calls for, *inter alia*, a package enclosing a single disposable garment-type absorbent article, wherein the package comprises a first and second piece of material, a seal, and an opening tab.

The article, while being part of the preamble of claim 21, offers no distinct definition of any of the claimed invention's limitations. Stated another way, the thrust of claim 21 is directed to the opening tab and the seal, not the article. Thus, we conclude that the particular article does not constitute or explain a claim limitation. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999) (“If, however, the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention's limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.”)

As set forth *supra*, claim 21 is not directed to the article, let alone the folded and unfolded configuration of the article, as contended by Appellant.

Thus, we affirm the rejection of independent claim 21 over Weinberger and Whitefoot.

Rejection of claims 22-24 under 35 U.S.C. § 103(a) over Weinberger, Whitefoot, and Denny or Anderson; and rejection of claim 25 under 35 U.S.C. § 103(a) over Weinberger, Whitefoot, and Narawa; and rejection of claim 26 under 35 U.S.C. § 103(a) over Weinberger and Whitefoot

Claim 22, from which claims 23-26 depend, calls for “wherein the first piece of material and the second piece of material have different rigidities.”

The Examiner's conclusion of obviousness for claims 22-24 relies on Denny or Anderson for describing a first and a second material having different rigidities (Ans. 14).

The Examiner's conclusion of obviousness for claims 25 and 26 does not address the claim limitation "wherein the first piece of material and the second piece of material have different rigidities," as called for in claim 22 (Ans. 13-15). As claims 25 and 26 depend on claim 22, it is possible that the Examiner intended to rely on Denny or Anderson as well for describing a first and a second material having different rigidities.

However, as set forth *supra* regarding the rejection of independent claim 1 over Weinberger, and Denny or Anderson; neither Denny nor Anderson describe a first and a second material having different rigidities, as called for in dependent claim 22.

Thus, for the same reasons set forth *supra* regarding the rejection of claim 1 over Weinberger, and Denny or Anderson, we reverse the rejection of claims 22-24 over Weinberger, Whitefoot, and Denny or Anderson; the rejection of claim 25 over Weinberger, Whitefoot, and Narawa; and the rejection of claim 26 over Weinberger and Whitefoot.

CONCLUSIONS

The Examiner has erred in concluding that claims 1, 3-5, 7-14 and 16-26 are indefinite for failing to particularly point out and distinctly claim Appellant's invention (App. Br. 8).

The Examiner has erred in finding that Denny describes a first piece of material and a second piece of material having different rigidities, as called for in independent claim 1.

The Examiner has not erred in finding that Whitefoot describes a single garment-type absorbent article, as called for in independent claim 21.

The Examiner has erred in finding that Denny describes an absorbent article having a ratio of the folded configuration to the unfolded configuration of less than 0.14, as called for in independent claim 11.

The Examiner has not erred in concluding that the combined teachings of Denny and Whitefoot would have rendered obvious the package, as called for in independent claim 21.

The Examiner has erred in concluding that the combined teachings of Weinberger, and Denny or Anderson would have rendered obvious a first piece of material and a second piece of material having different rigidities, as called for in independent claim 1.

The Examiner has erred in finding that Weinberger describes a single disposable garment-type absorbent article, as called for in independent claim 11.

The Examiner has not erred in concluding that the combined teachings of Weinberger and Whitefoot would have rendered obvious the package, as called for in independent claim 21.

DECISION

The decision of the Examiner to reject claim 21 over prior art is affirmed.

The decision of the Examiner to reject claims 1, 3-5, 7-14 and 16-26 under 35 U.S.C. § 112; and claims 1, 3-5, 7-14 and 16-20, and 22-26 over prior art is reversed.

Appeal 2009-012054
Application 10/749,988

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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